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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/768,606 12/18/96 BUSEY

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EXAMINER

LM01/0119

STEVEN R SPRINKLE  
GARY CARY WARE & FREIDENTICH LLP  
SUITE 1440  
100 CONGRESS AVENUE  
AUSTIN TX 78701

KINDRED, A

ART UNIT

PAPER NUMBER

2776

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
08/768,606

Applicant(s)  
Busey et al.

Examiner  
Kindred

Group Art Unit  
2776



☒ Responsive to communication(s) filed on 12-18-96

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 10-65 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 10-65 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Art Unit: 2776

### DETAILED ACTION

1. This action is responsive to communications: Amendment D, filed on 11/05/99.  
  
This action is made final.
2. Claims 10-65 are pending. Claims 10, 28, and 48 are independent claims.
3. The rejection of claims 10-65 under 35 U.S.C. 103(a) as being unpatentable over Judson, U.S. Patent Number 5,572,619, filed 10/19/95, class 395/793, title "Web browser with dynamic display of information objects during linking", in view of Liles, U.S. Patent Number 5,88,731, filed 12/1995, class 345/349, title "Use of avatars with automatic gesturing and bounded interaction in on-line chat session" has been withdrawn as necessitated by the amendment filed 11/05/99.
4. The present title of the application is "Method and apparatus for embedding chat functions in a web page".

### *Claim Rejections - 35 U.S.C. § 103*

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

Art Unit: 2776

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 10-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Volano, “VolanoChat Java solution turns ordinary web sites into interactive money makers”, Business Wire, pp.1-2, in view of Judson, U.S. Patent Number 5,572,619, filed 10/19/95, class 395/793, title “Web browser with dynamic display of information objects during linking”,

With respect to independent claim 10, Volano discloses “embedding a chat region within the browser region on the display device, the chat region being a real time continuously open bi-directional communications chat region” (“VolanoChat works with all Java-compatible browsers . . . can accommodate large numbers of simultaneous real-time interactions . . . such as browser plug-ins, Internet chat . . .”--page 1 of 2). Volano does not disclose “in response to a command received by a computer, establishing a browser . . .”. Judson discloses “in response to a command received by a computer, establishing a browser . . .” (“client machine having a browser, wherein the information objects are downloading of a hypertext object, selectively displaying one of the stored information objects . . .”--column 10, line 53). It would have been obvious at the time of the invention for one of ordinary skill in the art to have combined the teachings of Judson “in response to a command received by a computer, establishing a browser . . .” (“client machine having a browser, wherein the information objects are downloading of a hypertext object, selectively displaying one of the stored information objects . . .”--column 10, line 53) with the teachings of Volano above, because using the steps of “in response to a command

Art Unit: 2776

received by a computer, establishing a browser . . .” would have given those skilled in the art the tools to create a browser in the an Internet environment. This give users the ability to user browsers to view and manipulate information on the Internet via commands of a computer.

With respect to dependent claim 11, Volano discloses “displaying the chat region and the browser region simultaneously on the display device; and allowing a user to concurrently perform a chat function, a browser function or both” (“simultaneous real-time interactions . . . user-group support . . .”--page 1 of 2).

With respect to dependent claim 12, Volano discloses “establishing the browser and chat regions on the display device, the command being received by the computer from a user or a computer network” (“optimized for novice Web users that just want to chat . . . all the Java chat applications . . .”--page 1 of 2).

With respect to dependent claim 13, Volano discloses “with a chat client resident on the computer, processing chat content using a browser server for display in the chat region; with a browser resident on the computer, processing a document or other content for concurrent display in the browser region” (“Volano markets Java solutions for multi-user environments . . . a Web-based chat solution written entirely in Java . . .”page 2 of 2).

With respect to dependent claim 14, Volano discloses “linking the chat client to the browser so that the chat client controls the content displayed in the browser region.”

Judson discloses “linking the chat client to the browser so that the chat client controls the content displayed in the browser region” (“the first hypertext document . . . link that initiates downloading

Art Unit: 2776

of the second hypertext document . . .”--column 8, line 45). It would have been obvious at the time of the invention for one of ordinary skill in the art to have combined the teachings of Judson “linking the chat client to the browser so that the chat client controls the content displayed in the browser region” (“the first hypertext document . . . link that initiates downloading of the second hypertext document . . .”--column 8, line 45) with the teachings of Volano above, because using the steps of “linking the chat client to the browser so that the chat client controls the content displayed in the browser region” would have given those skilled in the art the tools to link chat data controls to the client. This gives users at the client the benefit of using browser functions when operating in the chat mode.

with respect to dependent claim 15, Volano discloses “linking the chat client to the browser through an application program interface of the browser” (“administrative features include modification of all user-interface text . . .”--page 1 of 2).

With respect to dependent claim 16, Volano discloses “in response to the chat content received by the computer, invoking the chat client through the application program interface, so that the chat content is displayed in the chat region” (“VolanoChat supports banner advertisements in its chat rooms . . .”--page 1 of 2).

With respect to dependent claim 17, Volano discloses “so that the chat content is displayed in the chat region, the chat content being of a particular MIME type” (“the first Java based chat solution . . . complete administrative control . . .”--page 1)

Art Unit: 2776

With respect to dependent claim 18, Volano does not disclose “so that the chat content is displayed in the chat region, the chat client including a file having a particular extension.” Judson discloses “so that the chat content is displayed in the chat region, the chat client including a file having a particular extension” (“supports files in the form of documents and pages . . . protocol that provides user access to files . . .”--column 3, line 53). It would have been obvious at the time of the invention for one of ordinary skill in the art to have combined the teachings of Judson “so that the chat content is displayed in the chat region, the chat client including a file having a particular extension” (“supports files in the form of documents and pages . . . protocol that provides user access to files . . .”--column 3, line 53) with the teachings of Volano above, because using the steps of “so that the chat content is displayed in the chat region, the chat client including a file having a particular extension” would have given those skilled in the art the tools to recognize and display data according the extension without opening the entire file.

With respect to dependent claim 19, Volano discloses “linking the chat client to the browser through the application program interface, the application program interface being implemented as a plug-in architecture” (“chat technologies, such as browser plug-ins . . .”--page 1 of 2).

With respect to dependent claim 20, Volano discloses “an ActiveX architecture” (“Volcano server runs on any platform that supports Java, including Microsoft . . .”--page 1 of 2).

With respect to dependent claim 21, Volano discloses “displaying the chat content in the chat region” (“Java based chat solution to offer in-room advertising . . .”--page 1 of 2).

Art Unit: 2776

With respect to dependent claim 22, Volano discloses “displaying the browser content in the browser region” (“Browser plug-ins, Internet Relay chat . . .”--page 1 of 2).

With respect to dependent claim 23, Volano does not disclose “the browser content including a markup language document.” Judson discloses “the browser content including a markup language document” (“HTML tag is a “comment,” . . . by the browser . . . HTML elements . . .”--column 5, line 6). It would have been obvious at the time of the invention for one of ordinary skill to have combined the teachings of Judson “the browser content including a markup language document” (“HTML tag is a “comment,” . . . by the browser . . . HTML elements . . .”--column 5, line 6) with the teachings of Volano above, because using the step of “the browser content including a markup language document” would have given those skilled in the art the tools to view markup language via a browser. This users the ability to view interact with information on the Internet.

With respect to claim 24, this claim is rejected on grounds corresponding to the arguments given above for rejected claim 3 and is similarly rejected.

With respect to dependent claim 25, Volano does not disclose “establishing the chat region embedded in the web page; and establishing the Web page embedded in the browser region.” Judson discloses “establishing the chat region embedded in the web page; and establishing the Web page embedded in the browser region” (the browser may be suitably programmed to queue the mini web page . . .”--column 6, line 42). It would have been obvious at the time of the invention for one of ordinary skill in the art to have combined the teachings of



Art Unit: 2776

Judson “establishing the chat region embedded in the web page; and establishing the Web page embedded in the browser region” (the browser may be suitably programmed to queue the mini web page . . .”--column 6, line 42) with the teachings of Volano above, because using the steps of “establishing the chat region embedded in the web page; and establishing the Web page embedded in the browser region” would have given those skilled in the art the ability to send and retrieve chat functions from embedded web pages and browsers. This allows users to communicate faster in chat rooms and the like.

With respect to claims 26 and 27, these claims are rejected on grounds corresponding to the arguments given above for rejected claim 3 and are similarly rejected.

With respect to independent claim 28 and dependent claims 29-47, these claims are rejected on grounds corresponding to the arguments given above for rejected independent claim 10 and dependent claims 11-27. In independent claim 28 and dependent claims 29-47, Applicant claims a system which contains means corresponding to the steps of the method of independent claim 10 and dependent claims 11-27.

With respect to independent claim 48 and dependent claims 49-65, these claims are rejected on grounds corresponding to the arguments given above for rejected independent claim 10 and dependent claims 11-27. In independent claim 48 and dependent claims 49-65, Applicant claims a computer program product which contains means corresponding to the steps of the method of independent claim 10 and dependent claims 11-27.

Art Unit: 2776

### **Response to Amendment**

7. Applicant's arguments with respect to claims 10-65 have been considered but are moot in view of the new ground(s) of rejection.

### **Conclusion**

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Hamilton, Pam, "Black sun interactive offers free VRML browser for real-time 3d multi-user interaction of the Internet; leading cyberspace technology developer to offer viewer, server and builder product set for Internet and Intranet virtual, Business Wire", pp. 1-2, 02/ 1996.

Mustang Software, "BBS out of the gate: wildcat 5 features HTML interface, realtime chat -- Mustang, seeking VARs, launches program", p. 1, 04/1996.

Hirshon, Jonathan, "WebMaster announces first IRC server software for Windows NT-based Intranets; conference room for Windows NT available at \$249 per server; fully supports Web and Intranet applications through International standards, plus multimedia functionality, OLE, Java, and Web browser support", pp. 1-2, 03/1996.

Art Unit: 2776

Moeller, Michael, "Sun is working on rebuilt hotJava as hosting environment. (Browsers take new turn) (Sun Microsystems) (Product development), pp. 1-2, 08/1996.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703)-308-9051 (**formal** communications intended for entry),

Or:

Art Unit: 2776

(703)-305-9724 (**informal** communications labeled **PROPOSED** or **DRAFT**).

Hand-delivered responses should be brought to:


Sixth Floor Receptionist, Crystal Park II, 2121 Crystal Drive, Arlington, VA.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alford Kindred, whose telephone number is (703)-305-3802 and can normally be reached Monday-Friday from 8:30 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Razavi, can be reached at (703)-305-4731.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the group receptionist whose telephone number is (703)-305-3900.

AWK

  
STEPHEN S. HONG  
PRIMARY EXAMINER